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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,435	10/21/2003	Mark F. Pittenger	640100.470	3718

7590 11/03/2005

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EXAMINER

SAJJADI, FEREDOUN GHOTB

ART UNIT

PAPER NUMBER

1633

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/690,435	Applicant(s) PITTENGER ET AL.	
	Examiner Fereydoun G. Sajjadi	Art Unit 1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, drawn to a method for producing cardiomyocytes and for improving ventricular wall motion in a heart of an individual, comprising administration of cardiomyocyte producing mesenchymal stem cells, classifiable in class 424, subclass 93.1.
- II. Claims 12-21, drawn to a method of repairing blood vessels or promoting angiogenesis in the heart of an individual, comprising administration of mesenchymal stem cells to heart tissue, classifiable in class 424, subclass 93.1.

The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions. The method of Group I pertains to a method for producing cardiomyocytes and for improving ventricular wall motion in a heart of an individual, comprising administration of mesenchymal stem cells. The method of Group III involves the repair of blood vessels or promotion of angiogenesis in the heart of an individual, comprising administration of mesenchymal stem cells to heart tissue. By contrast, the method of Group I is not directed to the promotion of angiogenesis, but rather, the production of cardiomyocytes. The promotion of angiogenesis or the repair of blood vessels of the heart requires cellular components, such as endothelial cells, that are distinct from cardiomyocytes. Hence, the cardiomyocyte producing mesenchymal stem cells of Groups I and II are not required for the angiogenesis promoting method of Group III and *vice versa*. Since the methods of Groups I and II are directed to different goals and there exists a number of different mesenchymal stem cells, and because said stem cells are known to be multipotent, the state of physiological environment into which mesenchymal stem cells are introduced impacts the differentiation of said stem cells, likely resulting in distinct outcomes.

In the instant case, the search of the different treatment conditions required for mesenchymal stem cells and subsequent differentiation of said stem cells are not coextensive. The search of inventions of Groups I-II together would therefore impose a serious search burden.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and are separately searched, and/or because of the patentably distinct species are listed above, it would be unduly burdensome for the examiner to search and examine all of the subject matter being sought in the presently pending claims, and thus, restriction for examination purposes as indicated is proper.

Applicant is advised that the response for this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications regarding the formalities should be directed to Patent Analyst Victor Barlow, whose telephone number is **(571) 272-0506**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fereydoun G. Sajjadi whose telephone number is **(571) 272-3311**. The examiner can normally be reached Monday through Friday, between 7:00 am-4:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave T. Nguyen can be reached on **(571) 272-0731**. The fax phone number for the organization where this application or proceeding is assigned is **(571) 273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

For all other customer support, please call the USPTO Call Center (UCC) at **(800) 786-9199**.

Fereydoun G. Sajjadi, Ph.D.
Examiner, USPTO, AU 1633



DAVE TRONG NGUYEN
SUPERVISORY PATENT EXAMINER